

REMARKS

This responds to the Office Action mailed on June 3, 2005, and the references cited therewith.

Claims 1, 5, and 12 are amended; as a result, claims 1-17 are now pending in this application.

§112 Rejection of the Claims

Claims 1-17 were rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness. The Examiner asserts that since FIG. 3 shows the accounting application and printing agent on the same server that the Examiner cannot figure out how the accounting services are external and separate from the printer agent. In response to this rejection, Applicants have amended the independent claims to strike the limitation of external and make the limitation “separate and apart.” Furthermore, Applicants note that the diagram is not ambiguous the accounting application is in fact separate and apart from the printer agent and the printer. Applicants cannot understand the perceived ambiguity, it is irrelevant that the printer agent and the accounting application are on the same server; they are still very clearly separate and apart from one another and not integrated into a larger single application. Accordingly, Applicants believe that there is no longer any ambiguity and that this rejection be withdrawn.

If the Examiner continues to maintain this rejection, then the Applicants respectfully request an explanation and interpretation as to how the accounting application and the printer agent are in fact the same when the figure asserted clearly shows the two components are separate and apart from one another. Any possible ambiguity was clearly removed with the word external, since arguable external may refer to a local environment; but separate does not refer to this. Separate refers to not being the same, and it is clear that the two are not the same. It is also abundantly clear that the two are apart from one another.

Accordingly, this rejection should be withdrawn. Applicants would also like to note that this rejection seems coincidental in view of the fact that the Examiner has been unable to find this limitation in the cited references and now appears to state that this limitation is obvious by official notice. Are Applicants to understand that the Examiner is now interpreting words against their ordinary meaning (*e.g.*, “separate and apart”) to find and create a non-existent

indefiniteness rejection and is coupling this with an official notice to reject the present claims? If Applicants have interpreted the rationale and logic of the Examiner correctly, then Applicants respectfully disagree with these actions and believe that these interpretations do not comport with the law of claim interpretation, the law of indefiniteness, and the law of obviousness.

§103 Rejection of the Claims

Claims 1-17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bennett et al. (U.S. 5,146,344). It is of course fundamental that in order to sustain an obviousness rejection that each and every element in the rejected claims must be taught or suggested in the cited reference or proposed combination of references.

Applicants respectfully disagree with the Official Notice taken by the Examiner. The Examiner asserts that the reference cited was provided in the mechanical arts and that in a computer environment it would have been obvious to modularize features and functions, such that the accounting services would be separate from the printer agent or printer. Applicants respectfully and strongly disagree with this conclusion.

First, the whole purpose of the Bennett printing system is a standalone system having features integrated therein, if that was broken down and stored in multiple environments outside the printer itself then Bennett would have more to manage and synchronize with the printer it teaches. Moreover, it would make the printer less portable since different environments would require different separately integrated features for their different environments. Applicants do not believe that making things more modular is always something that is desired or wanted in a computer environment and therefore do not believe that it is proper for the Examiner to be asserting an Official Notice in this area. Bennett's goal is to sell a printer. Applicants' goal is to provide network printing services for printers but not a specific type of printer. One of ordinary skill in the art would have understood this in reading Bennett and would have recognized that separating features and functions to devices outside the printing system, was not desirable and cannot therefore be said to be obvious. It is clear that this limitation is not present in the Bennett reference and that the Examiner is attempting to exclude the limitation of "accounting services separate and apart from a printer agent and a printer," with untenable interpretations of the

original filed specification and with no sequitors with respect to what one of ordinary skill in the art would have done with Bennett in view of the general computer programming field.

Again, Applicants disagree that it would always make sense to make features modular. It is the requirements of a project and that project's goal, which may or may not determine how an implementation is going to proceed. The Bennett reference would not illicit such a conclusion or need in one of ordinary skill in the art, because Bennett wanted a standalone printing system with all its features and functions self contained and not dependent on other environments because Bennett wanted to sell and invent a printer and self contained printer system. Therefore, Applicants respectfully assert that the Official Notice is inappropriate and that any presumption created by the Examiner is rebutted herewith and the burden is now with the Examiner to maintain the Notice, since a mere objection to an Official Notice puts the burden back on the Examiner to continue to maintain it. Moreover, the Examiner must provide specific evidence or an affidavit to continue to maintain this rejection. Applicants have more than provided sufficient remarks to elucidate why it is not obvious to simply suggest that the computer arts would have rendered the features of Bennett to have been made separate and apart from the Bennett printing system.

The Examiner admits that any Bennett accounting services are not separate from any Bennett printer agent or Bennett printer; however, the Examiner attempts two rejections to explain this away. First, the Examiner tries to stretch the ordinary meaning of words, such as "separate and apart" to suggest an indefiniteness problem exists, where there is clearly none in the first instance. Second, the Examiner has attempted to include an entire art area, namely computer programming, to suggest the limitation is obvious in Bennett, even when Bennett's teachings do not support such an arrangement since it would not be beneficial to Bennett's teachings and would in fact run contrary to the goals and teachings of Bennett. Moreover, making something modular in the programming arts is not always done. In fact, any decision to make something modular is driven by requirements and goals; the goals and requirements of Bennett would not have supported the conclusion being drawn by the Examiner.

Accordingly, the Applicants respectfully request that the rejections be withdrawn and the claims allowed.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at (513) 942-0224 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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By their Representatives,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 6 day of September, 2005.

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